

### **REMARKS/ARGUMENTS**

This Amendment is in response to the Office Action mailed September 8, 2009.

In the Office Action, the Examiner rejected claims 1-3, 5-8, and 10 under 35 U.S.C. § 101 and claims 1-3, 5-8, and 10 under 35 U.S.C. § 103.

Applicant has amended independent claims 1 and 6 to clarify embodiments of the invention.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

#### ***Rejections Under 35 U.S.C. § 101***

Claims 1-3, 5-8, and 10 stand rejected under 35 U.S.C. § 101 as the Examiner has alleged that the claimed invention is allegedly directed to non-statutory subject matter.

#### **Claims 1-3 and 5**

Regarding claims 1-3, and 5, the Examiner alleges that independent claim 1 is allegedly not tied to a specific machine and is non-statutory under 35 USC §101. (Office Action, page 3).

Although, Applicant respectfully disagrees with the rejection, in order to expedite the prosecution of the case, Applicant has amended independent claim 1 to recite: A method of operating a content delivery system implemented by a server computer for distributing advertising content to users of personal computers, the method comprising...collecting identification data from a network of personal computers, wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment...receiving the advertising content from an advertiser...receiving preference data from the personal computers, wherein the preference data is selected by the user of the personal computer...selecting the advertisement content that is to be distributed to the personal computers based upon the received preference data from the personal computers and the pre-determined conditions related to

advertisement distribution...formatting the advertising content for storage and display in the personal computers while or before bootloading a user selected application environment; and...distributing, using the collected identification data, the formatted advertising content to the personal computers.

Regarding claims 1-3 and 5, Applicant respectfully submits that under the Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101 (August 2009) that amended independent claim 1 is clearly statutory. A server computer is a statutory machine (See § 101 Examination Instructions Memorandum). Further, to the extent it is regarded as a process it is stated that the test for a process claim is whether the claimed method is (1) tied to a particular machine or apparatus or (2) transforms a particular article to a different state or thing. (*In re Bilski*). This is called the machine-or-transformation test.

In *Ex Parte Dickerson*, the Board of Patent Appeals and Interferences states: “We find that claims 23, 29, and 30 recite a computerized method which includes a step of outputting information from a computer (FF 7 and 9-10) and therefore, are tied to a particular machine or apparatus.” *Ex Parte Dickerson*, Board of Patent Appeals and Interferences, Appeal 2009-001172, July 9, 2009).

In view of the § 101 Examination Instructions Memorandum and *Ex Parte Dickerson*, Applicant respectfully submits that amended independent claim 1 reciting: A method of operating a content delivery system implemented by a server computer for distributing advertising content to users of personal computers...comprising...is clearly statutory.

Thus, Applicant respectfully requests that the rejection of claims 1-3 and 5 under 35 USC §101 be withdrawn in light of the amendments to independent claim 1.

#### Claims 6-8 and 10

Regarding claims 6-8 and 10, the Examiner alleges that independent claim 6 is software *per se* and does not involve computer components and is non-statutory under 35 USC §101. (Office Action, pages 3-5).

Although, Applicant respectfully disagrees with the rejection, in order to expedite the prosecution of the case, Applicant has amended independent claim 6 to recite: A content delivery system for distributing advertising data to a network of personal computers, the content delivery system including a server computer, the server computer comprising...an identification database comprising identification data, wherein the identification data uniquely identifies a computer or a user in the network of personal computers...an advertisement database comprising advertising data, wherein the advertising data is formatted for storage and display in the network of personal computers while or before the network of personal computers bootload a selected application environment...a collection module for collecting the identification from the network of personal computers and storing the collection information in the identification database...a formatting module for formatting and storing advertisement data in the advertisement database, wherein the advertising data is formatted for storage and display in the personal computers while or before bootloading a user selected application environment...and...a control module to...receive preference data from the personal computers, wherein the preference data is selected by the user of the personal computer...select the advertisement content that is to be distributed to the network of personal computers based upon the received preference data from the personal computers and the pre-determined conditions related to advertisement distribution...and...distribute the formatted advertising data to the network of personal computers.

Regarding claims 6-8 and 10, Applicant respectfully submits that under the Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101 (August 2009) that amended independent claim 6 is clearly statutory. A server computer is a statutory machine. (See § 101 Examination Instructions Memorandum). Further, to the extent it is regarded as a process it is stated that the test for a process claim is whether the claimed method is (1) tied to a particular machine or apparatus or (2) transforms a particular article to a different state or thing. (*In re Bilski*). This is called the machine-or-transformation test.

In *Ex Parte Dickerson*, the Board of Patent Appeals and Interferences states: “We find that claims 23, 29, and 30 recite a computerized method which includes a step of outputting information from a computer (FF 7 and 9-10) and therefore, are tied to a particular machine or

apparatus.” *Ex Parte Dickerson*, Board of Patent Appeals and Interferences, Appeal 2009-001172, July 9, 2009).

In view of the § 101 Examination Instructions Memorandum and *Ex Parte Dickerson*, Applicant respectfully submits that amended independent claim 6 reciting: a content delivery system for distributing advertising data to a network of personal computers, the content delivery including a server computer, the server computer comprising... is clearly statutory. In particular, it is “tied to a particular machine or apparatus,” namely, it is implemented by a server computer such that claims 6-8 and 10 clearly satisfy the machine test.

Thus, Applicant respectfully requests that the rejection of claims 6-8 and 10 under 35 USC §101 be withdrawn in light of the amendments to independent claim 6.

### ***Rejection Under 35 U.S.C. § 103***

Claims 1-3, 5-8 and 10 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent No. 5,948,061 issued to Merriman (hereinafter Merriman) in view of U.S. Patent No. 6,373,498 issued to Abgrall (hereinafter Abgrall).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Further, as is well known in obviousness determinations, impermissible hindsight reconstruction must be avoided. MPEP § 2142.

In *KSR International Co. vs. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” The Court further required that an

explicit analysis for this reason must be made. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 127 S.Ct. at 1741, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Further, it goes almost without saying that if a prior art reference is cited that requires some sort of modification in order to meet the claimed invention or requires some modification in order to be properly combined with another reference and such a modification destroys the purpose or function of the invention disclosed in the reference, one of ordinary skill in the art would not have found a reason to make the claimed modification. MPEP §2145.X.D. Thus, the Federal Circuit has consistently held that when a § 103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the prima facie case of obvious cannot be properly made.

Applicant has amended independent claims 1 and 6 to clarify embodiments of the invention. Utilizing amended independent claim 6 as an example, amended independent claim 6 includes claim limitations generally directed to: A content delivery system for distributing advertising data to a network of personal computers, the content delivery system including a server computer, the server computer comprising...an identification database comprising identification data, wherein the identification data uniquely identifies a computer or a user in the network of personal computers...an advertisement database comprising advertising data, wherein the advertising data is formatted for storage and display in the network of personal computers while or before the network of personal computers bootload a selected application environment...a collection module for collecting the identification from the network of personal computers and storing the collection information in the identification database...a formatting module for formatting and storing advertisement data in the advertisement database, wherein the advertising data is formatted for storage and display in the personal computers while or before bootloading a user selected application environment...and...a control module to...receive preference data from the personal computers, wherein the preference data is selected by the user of the personal computer...select the advertisement content that is to be distributed to the

network of personal computers based upon the received preference data from the personal computers and the pre-determined conditions related to advertisement distribution...and...distribute the formatted advertising data to the network of personal computers.

Applicant respectfully submits that amended independent claims 1 and 6 are not rendered obvious by the proposed combination of Merriman and Abgrall, or the other references cited by the Examiner, because these references alone or in combination do not teach or suggest the claim limitations of amended independent claims 1 and 6. Further, attempting to combine Merriman with Abgrall to in hindsight reconstruct Applicants' claims is not permissible, because such a modification would render Merriman unsatisfactory for its intended purpose.

First, Applicant respectfully submits that the Examiner has misinterpreted the teachings of Merriman and that Merriman does not teach or suggest Applicant's claim limitations related to a control module of a server computer that: ...receives preference data from personal computers, wherein the preference data is selected by the user from the personal computer.

It should be noted that Applicant describes in the specification of the patent application that various types of preference data such as movies, music, sports, games, news, television, etc. may be particularly selected by the user such that, based upon user selection preference data, advertisement content related to the user's selection will be distributed to the user.

Applicant respectfully submits that Merriman is related to a very different invention. As to Merriman,

The basic operation of the system is as follows...When a user browsing on the Internet accesses an affiliate's web site 12, the user's browser generates an HTTP message 20 to get the information for the desired web page. The affiliate's web site in response to the message 20 transmits one or more messages back 22 containing the information to be displayed by the user's browser. In addition, an advertising server process 19 will provide additional information comprising one or more objects such as banner advertisements to be displayed with the information provided from the affiliate web site. Normally, the computers supporting the browser, the affiliate web site and the advertising server process will be at entirely different nodes on the Internet. Upon clicking through or

otherwise selecting the advertisement object, which may be an image such as an advertisement banner, an icon, or a video or an audio clip, the browser ends up being connected to the advertiser's server or web site 18 for that advertisement object. (Col. 3, lines 5-23, emphasis added).

In Merriman, when a user accesses an affiliate's web site, an advertising server processor provides additional advertisements to be displayed with the information provided by the affiliate's web site. Thus, in response to requests from an affiliated web site, an advertising server transmits to users accessing the page of the affiliated web site, additional advertisements based upon profiling of the user. Applicant respectfully submits that there is no teaching or suggestion in Merriman of a control module of a server computer that receives preference data from the personal computers, wherein the preference data is selected by the user from the personal computer.

On page 6 of the Office Action, the Examiner cites column 5, lines 50-63 as being particularly relevant to receiving preference data from personal computers. This section of Merriman teaches:

If the user is an existing user, the ad server 19 obtains from a database all of the information known about the user including the user's geographic location, the domain type (commercial educational, governmental, the Internet service provided), the organization type where the user works (for example a SIC code), the company size, the number of employees in that company, the particular types of advertisements that the user has clicked on by SIC or other appropriate coding and the number of times that the user has been exposed to each advertisement currently in the system as described in FIG. 3A. Also, the relative time of day for the user is calculated based upon either the user's country code or the user's IP access provider or the location of their domain.

Applicant respectfully submits that an ad server that obtains information from a database about a user such as the user's geographic location, domain type, company size, number of employees in company, the particular types of advertisements that the user previously selected, etc., in no way teaches or suggests Applicant's claim limitations directed to receiving preference data from a personal computer *wherein the preference data is selected by the user of the personal computer*.

Second, Applicant respectfully submits that the Examiner has misinterpreted the teachings of Merriman and that Merriman does not teach or suggest Applicant's claim limitations related to: a formatting module for formatting and storing advertisement data in the advertisement database, wherein the advertising data is formatted for storage and display in the personal computers....

On page 6 of the Office Action, the Examiner cites column 4, lines 20-42 as being particularly relevant to formatting advertisement content for storage and display in a personal computer. This section of Merriman teaches:

FIG. 2 shows the ad server architecture. The ad server, which may comprise one or more servers uses a database 54 that will be described below and performs reporting processes 59, management processes 58, derivation of profile processes 52 and advertisement processes 19. The derive profile process 52 is how the advertisement server gathers information about individual users or TCP/IP networks for individual users. Advertisements, which may be advertisement banners are stored within the ad server process 19 as part of the advertising server process 19 and are periodically updated and refreshed. The advertisement server process 19 is used for responding to requests from advertisements provided by the user's as described above. The management process 58 is used for updating the various advertisements and overall control of the advertising server process 19 and also permits the advertisers to interface with the database to obtain up to the date reports on the placement of the advertisements. The report process 59 is used for generating online reports about the success rate of the advertisement and statistics on the users that are viewing and clicking through on various advertisements and also updating the counters in the database that store how often an advertisement has been displayed.

As described in Merriman, Merriman describes an ad server architecture that comprises a database to perform reporting processes, management processes, profile processes and advertisement processes. Contrary to the Examiner's assertion, there is absolutely no teaching or suggestion of a formatting module for formatting and storing advertisement data in the advertisement database, wherein the advertising data is formatted for storage and display in personal computers, as recited in Applicant's claims. There is absolutely no teaching or suggestion in Merriman of *formatting advertising data for storage by personal computers*.



As recognized by the Examiner on page 6 of the Office Action, Merriman does not disclose the following limitations: “wherein the personal computers are configured to display the advertising content while or before bootloading a user selected application environment.” The Examiner merely utilizes Abgrall for this alleged teaching and attempts to combine Abgrall with Merriman to, in hindsight, reconstruct Applicant’s claims. Abgrall is directed to: A method and apparatus to display an image during a transition of an operating system in a computer system...An image having an image format compatible with the operating system is obtained...Content of a system file corresponding to the transition of the operating system is created using the image in a system directory. (Abgrall, Summary, col. 1, lines 30-35).

Third, even assuming arguendo that Merriman teaches what the Examiner asserts, Abgrall is not properly combinable with Merriman. Attempting to combine Merriman with Abgrall to, in hindsight, reconstruct Applicants’ claims, is not permissible. This is because such a modification would render Merriman unsatisfactory for its intended purpose. Merriman is directed to an advertiser server, that, based upon information sent from a user’s browser, including the current web page being accessed, determines an advertisement for the user and sends the advertisement to the user’s browser for display. (Merriman, col. 2, lines 25-45).

Merriman cannot be combined with Abgrall to teach or suggest Applicant’s claim limitations directed to a server computer that formats advertising content for storage and then display on a personal computer while or before bootloading a user selected application environment - because this would destroy Merriman’s intended function. Merriman’s intended function is implementing an advertiser server that determines an advertisement for a user based upon the web site the user is currently browsing and sending the advertisement to the user’s browser for automatic and current display on the browser. There is no justifiable motivation to change Merriman’s advertising server to format advertising content for storage (e.g. on a disk of the personal computer) and then display on a personal computer while or before bootloading an application selected by the user as this would destroy the intended function of Merriman to quickly display an advertisement on a user’s browser. Application programs, such as the user browser of Merriman, are not available during the boot process of a computer and Merriman’s function cannot therefore be achieved during the boot or pre-boot phase.

Therefore, attempting to combine Merriman with Abgrall to in hindsight reconstruct Applicant's claims is not permissible, as such a modification would render Merriman unsatisfactory for its intended purpose. Accordingly, Merriman and Abgrall are not properly combinable. Moreover, as previously described in detail, amended independent claims 1 and 6 are not rendered obvious by the proposed combination of Merriman and Abgrall, because these references alone or in combination, do not teach or suggest the claim limitations of amended independent claims 1 and 6.

Accordingly, Applicant respectfully submits that amended independent claims 1 and 6, and the claims that depend therefrom, are distinguishable over the prior art references and Applicant respectfully requests that these claims be allowed and passed to issuance.

***Conclusion***

In view of the remarks made above, it is respectfully submitted that pending claims 1-3, 5-8, and 10 are allowable over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

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